

Question Q217

National Group: Mexico

Title: The patentability criteria for inventive step / non-obviousness

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Questions

I. Analysis of current law and case law.

The Groups are invited to answer the following questions under their national laws:

Level of inventive step / non-obviousness

1. What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?

Formally there is no standard defined for evaluation of inventive step in Mexico.

However, under the Mexican Industrial Property Law (IPL), the standard should be the problem – solution approach. The reasons are as follows:

*Under Article 12 Fraction III, Inventive Step is defined as “**the creative process which results may not be deducted evidently from the prior art by a technician in that subject matter**”*

By definition, a deductive analysis implies constructing a syllogism based on premises (from the prior art) that lead to a specific necessary conclusion in order to make such syllogism true. In order to make possible an inventive step analysis, a technician in a determined subject matter must face a problem to solve. In order to solve such a problem, it must be assumed that the technician will refer to the prior art and its teachings for a solution. The

technician will construct syllogisms based on prior art premises or statements in order to deduct a solution that is expected to work. Such solution should be compared to the solution proposed by the patent in order to verify if it is the same solution or not. If the same solution is reached, the invention would not be the result of an inventive step, but rather the result of a “deductive process”.

Furthermore, this approach is consistent with the same IPL, which expressly recognizes (Art. 19 Fraction VIII) that certain combinations of known inventions or modifications thereof might be patentable if they “cannot work separately”, i.e in a synergistic effect, or produce an “industrial result or use that are non-obvious by a technician in that subject matter” (that is, the deduction from the prior art will lead the technician to a result different than the one obtained by combining the inventions or by the novel use).

Under this “deductive” approach, if properly used, the hindsight problem is not present, since the technician will expect such solution to work based only on premises of the prior art, without taking into account the analyzed invention.

Whereas this approach may seem at first sight as similar to the “teaching-suggestion-motivation” approach used previously in the US, the “deductive” approach does take into account the ability of reasoning by the technician, and therefore, the selection of the premises from the prior art might not necessarily (at least by statute) need an express teaching or suggestion, but rather a result necessarily following the premises by the prior art combined by the technician.

In the practice, the Mexican Institute of Industrial Property (IMPI by the Spanish initials) seems to apply the problem – solution approach and its officers have publicly stated that they intend to apply the same when examining patents with regard to inventive step. However, deviations are found in the practice due to lack of training of some examiners.

Unfortunately no court decisions are available on the analysis of inventive step.

2. Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?

No, the standard has remained the same and the problems related to technical / industrial evolution in Mexico are of the nature expressly excluded from the scope of this question, namely, selection inventions, definition of the person skilled in the art, new use, computer implemented inventions, etc.

3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?

No, IMPI does not publish such guidelines, but in the opinion of the Mexican group they are necessary to clarify inventive step analysis.

4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?

No, however, judges are usually not familiar with patent cases and the use of expert witnesses becomes crucial for litigation proceedings.

Construction of claims and interpretation of prior art

5. How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?

Article 21 of the IPL is clear in stating that "The rights conferred by a patent are determined by the approved claims. The description and drawings or, if that is the case, the biologic material deposit to which Article 47 Fraction I of the Law refer to, shall serve for interpretation thereof"

In turn, Article 47 states that the description "shall be clear and complete enough as to allow a full interpretation thereof and, if that is the case, to enable a person with mean knowledge of the subject matter and expertise to put into practice the invention. Furthermore, it shall include the best mode known by the applicant to practice the invention, whenever that mode is not clear from the description, as well as the information exemplifying the industrial applicability of the invention."

Article 47 of the IPL was amended regarding the "industrial applicability" examples with effect as of September, 2010.

According to the above law, it is clear that claim construction is made in Mexico under a literal approach. However, the IPL itself provides for certain degrees of interpretation based on the description, as well as certain flexibility as to what a person with "mean knowledge and expertise" in the art might interpret from the same. However, this interpretative approach is only used when the claims "alone" are not clear enough, and is not used systematically as a construction method.

6. Is it possible to read embodiments from the body of the specification into the claims?

Based on the answer to question 5, it is possible as the description can be used to interpret the claims, provided that the claims cover a broader scope than the embodiments of the specification.

7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?

As mentioned in Question 1, prior art is read as interpreted by a person skilled in the art (the "technician in the subject matter")

With regard to inherency, there are no court decisions or specific law covering interpretation of inherent results from the prior art. Usually examiners try to construct arguments related to lack of inventive step basing the rationale on deductive reasoning from prior art pieces. For instance, inventions derived from known processes may lead to "new" products that might not be considered as involving an inventive step, under the argument that they were previously undetected because of lack of proper analysis techniques.

*On the other hand, inherency in Mexico is more similar to an express indication of the fact that "discoveries consisting of uncovering or revealing something that already existed in nature, **even if they were previously unknown to mankind**". This statement is found in*

Article 19 Fraction II amongst the developments that are expressly excluded from the definition of invention under the IPL.

The above may be interpreted under one of two approaches:

- a) *Literal: It is excluded from patentability only what existed in nature, that is, without intervention of man, even if it was previously unknown.*
- b) *Interpretative: It is excluded from patentability any phenomenon occurring inherently to the "nature" of what is known by man. In other words, even though something occurred already by practicing an invention but in such a way that it was unknown to mankind, the intent of the article is to prevent someone to patent a result that, although might not be obvious, would be necessarily used by practicing the prior art.*

Although there are experiences of use of both approaches in litigation, no court decisions have confirmed one or the other. However, the Mexican group believes that the intent is option b).

8. Do the answers to any of the questions above differ during examination versus during litigation?

No, however, judges are usually not familiar with patent cases and the use of expert witnesses becomes crucial for litigation proceedings.

Combination or modification of prior art

9. Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference? If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?

There are no limitations on the IPL regarding whether the prior art involved in analyzing inventive step should be one piece or several. Whereas in the practice there are several, for patent examination with one piece of prior art an argument by the examiner as a skilled person in the art, along with the common general knowledge available to those persons skilled in the art, is usually part of the arguments to consider in an objection to inventive step.

10. What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?

In the practice two or more prior art pieces may be combined through an explicit teaching or motivation, but the main driver for consideration of a relevant document is whether those skilled in the art would consult or consider a determined document necessarily to solve the problem.

11. When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed? How relevant is the problem the inventor of the claim in question was trying to solve?

The closeness of the technical field is relevant but the problem solved is of the essence under Mexican law and practice. As explained in Question 1, combinations of known inventions or variations thereof are patentable if these are not obvious to those skilled in the art.

Accordingly, if a set of documents in the prior art are not dealing with the same problem but the teachings are combined so as to form a new invention that cannot work separately for the same purpose, or in such a manner that the result is unexpected to those skilled in the art, the invention will be considered as having inventive step, because there would not be any reason for those skilled in the art to combine the teachings because the result would either not solve the problem or have a poor performance.

Obviously, the closer the documents are to the field of the analyzed invention, the higher is the likelihood of considering that the invention does not imply an inventive step. However, even such cases, where prior art is very close to the field, the nature of the problem solved and what a person skilled in the art expects based on the prior art is what will drive the conclusion.

12. Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?

As mentioned in question 10, there are no limitations on the number of pieces of prior art under Mexican IPL, and the standard will not change according to the number of documents or references considered for examination.

13. Do the answers to any of the questions above differ during examination versus during litigation?

The reasons for those skilled in the art to combine documents or teachings are simply “taken for granted” during prosecution. However, when it comes to litigation, such reasons must be properly supported by prior art references such as books, scientific publications or the like, whereby the selection of the documents and the conclusions reached by the person skilled in the art becomes critical along with the expert witness.

Technical Problem

14. What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?

As mentioned in the former questions, the technical problem to be solved is of the essence under Mexican practice because it will determine the nature of the deductive analysis to be made under the prior art.

15. To what degree, if any, must the technical problem be disclosed or identified in the specification?

*The technical problem must be expressly disclosed in the specification. Under the Regulations of the Mexican IPL (Article 28 Fraction IV of the IPL Regulations) the description must “Specify the invention, as claimed, in such clear and exact terms that **shall allow the comprehension of the technical problem, even if it is not expressly designated as such**, and shall give the solution to the same, explaining the advantageous effects of the invention, if any, with respect to the prior art.”*

Advantageous effects

16. What role, if any, do advantageous effects play in determining inventive step or non-obviousness?

Advantageous effects are very important in determining the inventive step because they set the limit on the expectations of those skilled in the art based on the prior art, as explained before in Question 1.

17. Must the advantageous effects be disclosed in the as-filed specification?

*As in the case of the technical problem, the advantageous effects must be expressly disclosed in the specification. Actually, based on the same Regulations of the Mexican IPL (Article 28 Fraction IV of the IPL Regulations) the description must "Specify the invention, as claimed, in such clear and exact terms that shall allow the comprehension of the technical problem, even if it is not expressly designated as such, shall give the solution to the same, **explaining the advantageous effects of the invention, if any, with respect to the prior art.**"*

18. Is it possible to have later-submitted data considered by the Examiner?

It is possible to have later-submitted data for consideration by the Examiner.

However, the acceptance of such data is conditioned. Additional data is accepted only in support to already described features, advantages or solutions, and it does not imply features beyond the scope of the original description. There is debate on whether such additional data constitutes additional subject matter or not, so as to include it in the specification in the form of additional examples, but in the practice the IMPI does not allow such inclusions usually, but accepts the information in support to already described features.

19. How "real" must the advantageous effects be? Are paper or hypothetical examples sufficient?

The nature of the examples will depend on the technical field and how far from the prior art is the invention, because there are cases where examples must demonstrate expressly the advantageous effects, such as in chemical, biotechnology or pharmaceutical inventions. The only requirement is that examples must guide those skilled in the art to put into practice the invention.

20. Do the answers to any of the questions above differ during examination versus during litigation?

As with the other questions, the role of expert witnesses in litigation is crucial because of the lack of experience of the judges.

Teaching away

21. Does your jurisdiction recognize teaching away as a factor in favor of inventive step / non-obviousness? Must the teaching be explicit?

Teaching away is the best factor in favor of inventive step because an indication teaching away from the invention precisely sets the expectative of result in those skilled in the art. If

references teach away from the invention, this means that the result of the invention is therefore unexpected.

Whether the teachings must be explicit or not would depend on the case, but definitely there must be elements for demonstrating that the prior art teaches away, whether or not expressly.

22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?

Teaching away is equally important, as it is one of the ways to demonstrate an unexpected result with respect to the prior art.

23. Is there any difference in how teaching away is applied during examination versus in litigation?

As with the other questions, the role of expert witnesses in litigation is crucial because of the lack of experience of the judges.

Secondary considerations

24. Are secondary considerations recognized in your jurisdiction?

The applicable law does not provide for secondary considerations in evaluating inventive step. In the practice, the Mexican patent office (Mexican Institute of Industrial Property) the examiners do not consider at all secondary considerations such as commercial success, but rely only on the technical issues regarding the deductibility of the technical features of the invention from the prior art.

25. If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the claimed invention and the secondary considerations required?

Not applicable pursuant to response to question 24.

25. Do the answers to any of the questions above differ during examination versus during litigation?

Not applicable pursuant to response to question 24.

26. Do the answers to any of the questions above differ during examination versus during litigation?

There are not any criteria on this approach defined by courts and therefore the outcome in a litigation case is uncertain.

Other considerations

27. In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction?

If yes, please describe these issues, tests, or factors.

a) Treatment of combinations or modifications of known inventions.

There are express indications in Article 19 fraction VIII of the Mexican IPL, which might be interpreted in the sense of inventive step, with regard to combinations or modifications of known inventions.

Generally, combinations or modifications of known inventions are considered not patentable under said provision of the IPL, but an exemption to such general criterion is made by the same article when:

- a) The known inventions are combined or fused in such a way that they cannot work separately.*
- b) The characteristic qualities or functions of known inventions are modified so as to obtain a non-obvious:
 - ✓ result; or
 - ✓ usewhere the non-obviousness is referred to those skilled in the art (the technician in the subject matter)*

*Even though this provision is somehow not clear because uses the term “non-obvious” as opposed to referring to the term “inventive step”, it is clear that the rationale behind the provisions is that combinations or modifications of known inventions are not excluded from patentability “per se”, but that the analysis by the examiners must go beyond the mere fact that there is a combination or modification of known things. The true spirit of this provision is making clear that **the result or new use** of the combination or modification of known inventions **is what must be evaluated** in the light of what those skilled in the art expect or know about the effect of such combination or modification.*

b) Relevant prior art in the case of interference between patent applications of different applicants unpublished at the time of filing or on the priority date.

Article 17 of the Mexican IPL states that the evaluation of novelty and inventive step must be made only based on prior art published prior to the filing date of the patent application, or if that is the case, prior to the recognized priority date.

*However, the same article states that, in order to consider if an invention is NEW, the prior art to be considered shall include those patent applications that were **filed in Mexico** prior to such date (that is, filing or priority date), under prosecution, even if the publication of such applications is made later. Obviously this provision is present in the law in order to avoid double patenting of the same invention by two different persons, considering that Mexico is a first-to-file system.*

The Regulations of the Mexican IPL further clarify in Article 22 thereof that there shall be included in the prior art to be considered for examination also those patent applications or utility model registration applications filed prior to those subject to substantive examination in date and hour. However, those applications that are rejected, retired or abandoned prior the publication of the same shall not be considered as part of the prior art for the sake of examination.

With regard to the issue on the relevant prior art, there is debate on whether those applications filed in Mexico prior to the filing or priority date of an examined application must be considered or not prior art for the purposes of evaluating

INVENTIVE STEP. The debate arises because of the fact that the reference in Article 17 of the Mexican IPL of unpublished patent applications filed in Mexico is made only regarding evaluation of novelty, whereas in the case of published prior art the reference is made to both, novelty and inventive step.

There are two positions on this issue, which remain unsolved due to lack of court criteria or jurisprudence. However, the patent office tends to adopt the second position (ii) detailed herein below:

- i) There are practitioners that consider that unpublished applications filed prior to the examined patent application must be considered prior art for the evaluation of both, novelty and inventive step. Under this approach, the omission of inventive step in the article when referred to unpublished Mexican applications is considered a non-intentional “omission” in the article that must be interpreted in the light of the intent of the first paragraph of the same, which refers to the two requirements for patentability that are evaluated based on the prior art.*
- ii) There is another group of practitioners that consider that the omission of “inventive step” in the paragraph referring to unpublished patent applications is intentional. The rationale is as follows:*
 - ✓ A patent application is evaluated with regard to inventive step if and only if it complies with the requirement of novelty. Therefore, if neither an unpublished application alone is enough to destroy novelty of the examined patent application, nor are enough other pieces of published prior art, inventive step must be evaluated.*
 - ✓ Accordingly, both applications, the unpublished but oldest patent application and the examined application are not the SAME invention, because the newer application is novel, otherwise inventive step should not be evaluated. Therefore, double patenting is necessarily **not** present.*
 - ✓ The inventor of the examined patent could not have had access to the knowledge and teachings of the unpublished patent to achieve any solution, even if both inventions solved the same problem. The teachings of the unpublished invention were not available for those skilled in the art at the time of filing the examined patent application, and those skilled in the art could not expect any results disclosed in the unpublished application.*
 - ✓ Therefore, lack of inventive step must be proven in the light of the knowledge available to those skilled in the art prior to the filing date of the examined application, knowledge that does not include the unpublished prior application. Accordingly, if the unpublished prior application is strictly necessary to demonstrate lack of inventive step, this means that without such piece of prior art nobody skilled in the art could deduct the results of the examined patent application (which, as stated before, is different because it is novel over the same document) and therefore, such unpublished prior art should not be considered for examining inventive step.*

Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and, if so, provide a brief summary of such interpretation.

There is not jurisprudence in Mexico with any statement of the test for inventive step. The only reference to a certain method is made in the law by defining inventive step as a result that cannot be obtained through a “deductive” process, which implies deductively demonstrating the same result based on the prior art. This deductive process implies basing a rationale clearly on premises taken from the prior art, combined by those skilled in the art so as to solve a specific problem.

29. Does such test differ during examination versus during litigation?

As there is not any jurisprudence, and the law must be applied by both, courts and the Mexican patent office, there are no differences with regard to the fact that a deductive process must be placed based on the prior art in order to demonstrate lack of inventive step.

Patent granting authorities versus courts

30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.

There are not further areas not covered above.

31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?

Rather than divergence in approach, there are not skilled judges and therefore the necessity of expert witnesses with knowledge about the patent system is fundamental during litigation.

Regional and national patent granting authorities

32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?

Not applicable to Mexico, where there is only one authority.

32. If yes, is this problematic?

Not applicable

II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

33. Is harmonization of inventive step / non-obviousness desirable?

Given the fact that there are several international treaties dealing with the concept of “inventive step/non-obviousness”, some level of standardization between countries signatory of TRIPS or the PCT might be beneficial for the international practice. The reason is that it is a practically universal requirement for patentability and not optional for those signatories of these treaties.

34. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?

Whereas the concept of inventive step may be universally recognized as a requirement necessary to ensure that patents are granted only to those that provide solutions through inventions beyond what those skilled in the art can obtain due to their formal studies and experience, achieving a standard is difficult because of the interpretative nature of the examination process, which in turn depends on the skills of the examiners and applicants to build arguments in favor or against such inventive step.

However, a standard on the method of evaluating inventive step is perfectly feasible, and even though it will very likely not be a standard that will have the same outcome when evaluated by different persons, the variability of the result would be reduced greatly. The challenge, rather than the method would be the ability of training both, examiners and applicants, on the methodology, in order to make it universal.

36. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.

The Mexican definition, as it refers to a process, is considered by the Mexican group as an option that might be broadly acceptable:

“the creative process which results may not be deducted evidently from the prior art by those skilled in the art”.

The reason is that the definition refers to two main tools for evaluation:

- a) A method for evaluation based on a deductive process.*
- b) A reference expressly made to a concrete result.*
- c) A clear indication that the evaluation has to be made based on prior art, which avoids hindsight.*
- d) An indication that the person that should make the deduction is a person skilled in the art and not any person.*

37. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.

- a) Determining the relevant prior art for evaluation of inventive step, which might be different than that for novelty (please refer to question 27).*
- b) Establishing the problem solved or the objectives of the analyzed invention*
- c) Constructing, based **only** on premises from the relevant prior art, a series of rationales leading to a solution that a person skilled in the art would DEDUCT necessarily from the prior art. This construction **MUST** make express references to the express statements of the relevant prior art that are used as premises. This does not mean necessarily an express suggestion, but rather an unquestionable premise that certain action will lead to a specific **EXPECTED** result. The reasons to combine prior art in this case **MUST** be part of the deductive process, which means that a reference is necessary if and only if those skilled in the art would look at it in seeking for a solution to the same problem.*

- d) *Comparing the solution obtained through the deductive process with the solution proposed by the examined claims. If the deducted solution is the same than the proposed by the claims, the claims lack of inventive step. If the solution is different or the deduction is impossible, the claims are the result of an inventive step.*